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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,694	11/03/2005	Matthias Niggemann	82351	1591
23685 7590 01/28/2008 KRIEGSMAN & KRIEGSMAN 30 TURNPIKE ROAD, SUITE 9 SOUTHBOROUGH, MA 01772			EXAMINER WEEKS, GLORIA R	
			ART UNIT 3721	PAPER NUMBER
			MAIL DATE 01/28/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



# Office Action Summary

**Application No.**

10/524,694

**Applicant(s)**

NIGGEMANN ET AL.

**Examiner**

Gloria R. Weeks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 February 2005.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-38 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 2/15/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

While Applicant recognizes the duty to disclose information, Applicant recites the phrase "material to the examination of this application", whereas the material should be drawn to the patentability of the application. Correction is required. See

***Specification***

3. The abstract of the disclosure is objected to because of the recitation of the phrase "said". Correction is required. See MPEP § 608.01(b).

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the

printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 19-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites the limitation "the marking unit" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

Claim 24 recites the limitation "the marking unit" in line 2 and "the reader" in line 3. There is insufficient antecedent basis for these limitations in the claim.

Regarding claim 25, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. Is the step of providing a marking unit and a reader at the specific distance limited to a filling plant or does it encompass other environments, such that a filling plant is merely an example of an environment in which the method can be implemented. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-9, 11-23, 26-30, 33 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnsen et al. (USPN 5,109,153).

In reference to claims 1-9, 11-18 and 38, Johnsen et al. discloses a method for producing a returnable and recyclable package including the steps of: applying at least one deposit mark to the packaging (column 3 lines 7-9), the deposit mark defined by at least one irremovable and visible security feature 14 in the form of a barcode, and at least one fluorescent/translucent (column 3 lines 23-41)/Stokes pigment (column 3 lines 53-66) further security feature 13 coincident with the at least one security feature 14 for the purpose of determining authenticity of the package; wherein at least one security feature 13, 14 is printed 16 directly on the package before the introduction of goods into the package (figure 4) in an in line process; a control system 20 predefining a deposit value 12 associated with the deposit value mark 13, 14; wherein the combination of the at least one first and further security feature 13, 14 define the deposit value/code 12 of the deposit mark; and at least one security feature 14 is readable by a machine (column 4 lines 8-9).

Regarding claims 19-23, 26-30 and 33, Johnsen et al. discloses a method of implementing a returnable packaging system characterized in that: at least one security feature 13, 14 is applied to a package by a marking unit 16, 19 which receives, from a control unit 20, a clock pulse

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(column 5 lines 25-39); each issue of a further security feature is passed on to a reader data processing system 28 after the marking unit 16, 19 and the further security feature is at least partly registered and stored (column 6 lines 11-33); wherein the marking unit 16, 19 is a short distance from the reader 28 (figure 5); and wherein the at least one further security feature 13 is applied using well known application methods, which include both contact or contactless applications (column 4 line 63-column 5 line 2).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Johnsen et al. (USPN 5,109,153) in view of Oshima et al. (USPN 6,303,929).

With respect to claim 10, Johnsen et al. discloses a method of applying a security feature to a package, wherein the security features is responsive to radiant energy for the purpose of allowing the security feature to be detected by the human eye. Johnsen et al. does not disclose the security feature having a rapid decay. Oshima et al. teaches a method of applying a security feature to a packaging, wherein the security feature has fluorescent pigment with a rapid decay constant (column 1 lines 42-52). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the method of Johnsen et al. to apply a fluorescent

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pigment security feature having a rapid decay, since column 2 lines 3-6 of Oshima et al. state that such a modification prevents adverse effect on the aesthetic appearance of the package.

11. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnsen et al. (USPN 5,109,153) in view of Soehnlén et al. (USPN 6,247,507).

In reference to claims 24 and 25, Johnsen et al. discloses a method of applying a security feature to a package, but does not specifically disclose the dimensions of the orientation of a marking unit that applies the security feature with respect to a reader. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the method of Johnsen et al. to provide a marking unit 62 positioned near a reader 72, since column 6 lines 43-52 of Soehnlén et al. state that such a modification allows a container to maintain proper orientation of a package for the purpose of acquiring product related information from the package. While the specific distance of 3 meters or less is not disclosed by Johnsen et al. and Soehnlén et al., Examiner finds that the method would have provided the same advantage of orientation of the package between the marking unit and the reader, as stated by Soehnlén et al., if the distance of 3 meters was exceeded.

12. Claims 31, 32 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnsen et al. (USPN 5,109,153) in view of Stoffelsma (PCT/DE2002/001566).

Regarding claims 31, 32, 34-37, Johnsen et al. discloses a method of applying a security feature to a package, but does not disclose the processing of the package post filling. Stoffelsma teaches a package return method for processing a package having a security feature, including the steps of: transmitting data from a filler to a clearing authority when empty containers are replaced by full containers (figure 1), wherein the data is checked, registered and stored by an

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EDP based management system (paragraphs 9 & 10). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the method of Johnsen et al. to include the return system of Stoffelsma, since paragraphs 14 and 19 of Stoffelsma suggest that such a modification prevents multiple deposit implementation and allows the packaging to be returned to a variety of locations having access to the EDP system for recycling purposes.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to attachment for notice of references cited and recommended for consideration based on their disclosure of limitations related to the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria R. Weeks whose telephone number is (571) 272-4473.

The examiner can normally be reached on M-F 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.




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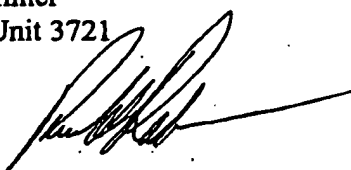
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grw  
April 24, 2007

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